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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,217	04/02/2001	Gunther Klenner	2206.0021C	9850
7590 06/28/2005				
EPSTEIN, EDELL & RETZER		EXAMINER		
Suite 400		TSE, YOUNG TOI		
1901 Research Boulevard		ART UNIT		
Rockville, MD 20850-3164		PAPER NUMBER		
		2637		

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/822,217

Applicant(s)

KLENNER, GUNTHER

Examiner

YOUNG T. TSE

Art Unit

2637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04022001.08112004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

1. The disclosure is objected to because of the following informalities: on page 1 (lines 8, 9 and 11), page 3 (lines 14 and 23), page 6 (line 19), and page 12 (lines 4 and 11), "net" is suggested to change to "system"; on page 1, lines 18-19, the information of the article seems not correspond to the information listed in the 1449 form, it is also needed to clarify the phrase "16/97"; and on page 5, line 21, "9.600" should be "9,600". Appropriate correction is required.

### ***Claim Objections***

2. Claims 1-16 are objected to because of the following informalities: in line 1 of claims 1 and 5, "Method" should be "A method"; in line 2 of claims 1, 5 and 13-14, "net" is suggested to change to "system"; in line 1 of claims 2-4 and 6-12, "Method" should be "The method"; and in claim 9 (line 2) and claim 12 (line 4), "a predetermined safety" should be "the predetermined safety". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to explain what is the second criterion or the second bit error rate as recited in claims 1, 5 and 13-14. Further, the specification also fails to mention the second criterion is determined from a first criterion and a first bit error rate is determined from the second bit error rate.

Claims 13 and 14 are single means. A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable

structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. See MPEP 2164.08(a).

Claims 13 and 14 recites a testing device for measuring the receiver sensitivity of communication terminals. However, no testing device is shown in the disclosure of the single drawing since it shows only the flowchart in the present invention. Also see claims 15 and 16.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-12 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims merely recite used without any active, positive steps delimiting how these use are actually practice. Without reciting any practice, positive steps, claims 1-12 do not achieve the purpose of a method.

In claim 2, line 1, "the "criterion" lacks antecedent basis since it is unclear "the first criterion" or "the second criterion".

In claim 3 (lines 1-2), claim 11 (lines 1-2), claim 12 (line 4), and claim 15 (line 2), the phrases "the second-pre-determined threshold value", "the first-pre-determined threshold value", "the necessary safety", and "the process of testing" all lack antecedent basis.

Claim 3 lacks cooperation with precedent claims.

In claim 6, the phrase "according to the CDMA standard" should not be included in the claim because it is already standard.

In claim 7, "the bit error rate" lacks antecedent basis since it is unclear "the first bit error rate" or "the second bit error rate".

In claim 10, "the data transmission rate" lacks antecedent basis since it is unclear "the pre-determined data transmission rate" or "the higher data transmission rate".

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1-16 are rejected under 35 U.S.C. 102(a) as being anticipated by the prior art discussion in the Description of the Prior Art of the instant application.

With respect to claims 1, 5 and 13-14, the invention recites a method or a testing device for operation in a digital communication system using a higher data transmission rate to conduct a testing of the receiver sensitivity and a measurement of the bit error rate in a faster manner than the known prior art. However, the claims fail to recite any specific rate for the higher data transmission rate. Therefore, the claimed subject matter of claims 1-16 is rejected over the prior art as discussed in the Description of the Prior Art in the instant application. See page 1, line 16 to page 3, line 2 and page 6, lines 23-32.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schneider et al. is related to a system for measuring the sensitivity of a receiver such as a receiver within a selective call device.

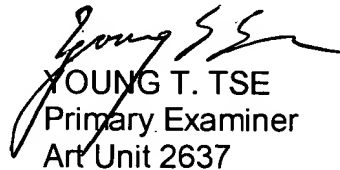
Wright et al. is related to a radio interference detection and screening system for to eliminate bit error rates during a Locomotive Control Unit sensitivity testing or bit error rate testing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOUNG T. TSE whose telephone number is (571) 272-3051. The examiner can normally be reached on Monday and Wednesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

However, starting July 15, 2005, the Central FAX Number will change to (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
YOUNG T. TSE  
Primary Examiner  
Art Unit 2637